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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732

EXAMINER

SAADAT, CAMERON

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,272

Applicant(s)

AU, I. S.

Examiner

Cameron Saadat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

In response to the request for reconsideration filed 1/06/04, claims 1-14 are pending in this application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Herman et al. (USPN 5,364,272; hereinafter Herman).

Regarding claims 1 and 13, Herman discloses an apparatus for determining the identification of selected objects for use in connection with an electronic children's toy, the apparatus comprising: a plurality of objects 14a-c which include a plurality of object contact elements 50a-h, wherein two or more of the contact elements are connected to form a contact pattern which serves to uniquely identify the object (Col. 4, lines 7-17); and an identification member 12a-c capable of being placed in physical contact with the object contact elements 50a-h (Col. 6, lines 42-56); the identification member including a plurality of member contact elements 46a-h configured such that at least two of the member contact elements come into electrical contact with at least two of the object contact elements when the identification member is placed in contact with one of the objects (Col. 4, lines 18-25); and a processing unit 20 in electrical contact with the identification member capable of detecting the object contact pattern and determining the identification of the particular object (Col. 5, lines 46-51).

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Regarding claims 2 and 14, Herman discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 6, lines 20-23).

Regarding claim 3, Herman discloses an apparatus comprising a means of providing audio information includes computer-generated human speech (Col. 6, lines 42-56).

Regarding claim 4, Herman discloses an apparatus wherein audio information is provided upon movement of a portion of the apparatus (Col. 6, lines 42-56).

Regarding claim 5, Herman discloses an apparatus wherein the identification member includes at least three contact elements 46a-h arranged linearly (See Fig. 2).

Regarding claims 6, Herman discloses an apparatus wherein the objects 14a-c include at least two contact elements 50a-h arranged such that each of the object contact elements comes into physical contact with a corresponding one of the identification member contact elements (Col. 3, line 63 – Col. 4, line 58).

Regarding claim 7, Herman discloses an apparatus wherein the identification member includes at least four contact elements 46a-h arranged in at least two linear rows. (See Fig. 2)

Regarding claim 8, Herman discloses an apparatus wherein the objects 14a-c include at least two contact elements 50a-h arranged such that each of the object contact elements comes into physical contact with a corresponding one of the identification member contact elements 46a-h (Col. 3, line 63 – Col. 4, line 58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herman et al. (USPN 5,364,272; hereinafter Herman) in view of Lewis (USPN 2,909,868).

Regarding claim 9, Herman discloses an electronic children's educational toy comprising: a plurality of objects 14a-c, each of said objects including a plurality of contact elements 50a-h wherein the contact elements are connected to one another to form a contact pattern which serves to uniquely identify each object (Col. 4, lines 7-17), and an identification member 12a-c capable of being placed in physical contact with the object contact elements 50a-h (Col. 6, lines 42-56); the identification member including a plurality of member contact elements 46a-h configured such that at least two of the member contact elements come into electrical contact with at least two of the object contact elements when the identification member is placed in contact with one of the objects (Col. 4, lines 18-25); and a processing unit 20 in electrical contact with the identification member capable of detecting the object contact pattern and determining the identification of the particular object (Col. 5, lines 46-51). Herman further suggests that the object and identification member may take the form of an interactive toy, such as a doll placed in physical contact with a chair (Col. 6, lines 42-56). Herman discloses all of the claimed subject matter with the exception of providing the identification member shaped *in the form a fishing pole and a hook member*. However, Lewis teaches an electronic children's educational toy, comprising a fishing pole device 30 and a hook member 32, wherein the hook engages with an aperture of object 6 to form an electrical contact between a contact of the hook 32 and contacts 25-26 of the object, thereby completing a

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circuit to provide visual feedback (Col. 2, lines 25-50) Hence, in view of Lewis, it would have been obvious to a person of ordinary skill in the art to modify the shape of the identification member and the toy object described in Herman, by providing an object identification member in the form of a hook in order to provide an interactive toy that elicits a reaction when physical contact is made between a hook and a toy fish.

Regarding claim 10, Herman discloses an apparatus further comprising a means of providing audio information corresponding to the identification of the object in contact with the identification number (Col. 6, lines 20-23).

Regarding claim 11, Herman discloses an apparatus comprising a means of providing audio information includes computer-generated human speech (Col. 6, lines 42-56).

Regarding claim 12, Herman discloses an apparatus wherein audio information is provided upon movement of a toy object with respect to the identification member (Col. 6, lines 42-56).

Response to Arguments

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Kitagawa et al. (USPN 5,334,022) – disclose an object identifier based on an object's optical contact pattern.
- Law et al. (USPN 5,639,093) – disclose a target casting practice method comprising the step of casting an object attached to a line at a receiving structure, wherein the receiving structure includes audio feedback.

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- O'Brien (USPN 5,297,355) – discloses a fly-fishing practice device, wherein a hook member and target create an electrical connection to provide visual feedback.
- Lurito (USPN 4,526,550) – discloses an educational matching game wherein an object identifier identifies objects based on contact patterns.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is 703-305-5490. The examiner can normally be reached on M-F 8:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

CS


Teresa Walberg
Supervisory Patent Examiner
Group 3700